REMARKS

Claims 1-18 and 22-46 are pending in the action, with claims 24, 26, and 44 being independent. Claims 24-26 and 44 are amended. Claims 47-50 are new. No new matter has been added.

Claim 25 stands rejected for allegedly being indefinite under 35 U.S.C. §112, ¶2.

Claims 24 and 25 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,360,254 ("Linden").

Claims 26-28 and 30-46 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2003/0083931 ("Lang").

Claims 1-3, 5-18 and 22-23 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Linden in view of Lang.

Claim 4 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Linden in view of Lang and U.S. Patent No. 6,321,208 ("Barnett").

Claim 29 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lang in view of Barnett.

The Applicant traverses these rejections. Reconsideration and allowance of the above-referenced application are respectfully requested in light of the following remarks.

Section 112, ¶2 Rejections

Claim 25 stands rejected as allegedly being indefinite. The Applicant has amended claim 25 to overcome this rejection.

Section 102(e) Rejections

Claims 24 and 25 stand rejected as allegedly being unpatentable over Linden. Independent Claim 24 recites in part, "receiving a coupon from a server" and associating a URL with the coupon, "the URL containing a promotional code."

Linden discloses a system in which users access private resources (e.g., Web pages, data records) with automatically generated private URLs that include a fixed character string and a

unique token. *See* col. 1, lines 40-67. The following is an example of an automatically generated URL per Linden:

http://www.amazon.com/private_resources/A9HBJ1E55G0ML

The character string "A9HBJ1E55G0ML" is the token, which encodes a user's e-mail address and a time stamp. *See* col. 8, lines 25-53. Private URLs are conveyed to users in e-mail messages, optionally in hyperlink form. *See* col. 7, line 63 to col. 8, line 4. A user can select a private URL hyperlink 74 in an gift certificate e-mail message 72 to cause the presentation of a web page that allows the user to redeem the gift certificate, for example. *See* FIGS. 9-10 and col. 10, line 58 to col. 11, line 11.

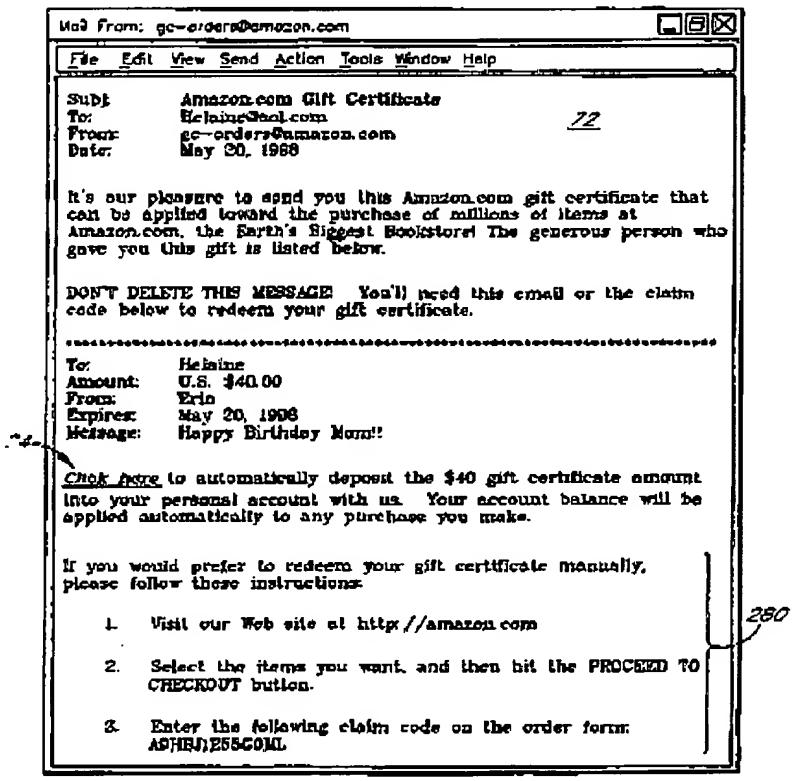

FIG. 9

Claim 24 recites a "promotional code" contained in a URL, while Linden describes a "token value." The relied upon portions of Linden do not teach that the token value is a promotional code. Linden does not even teach that the token value relates to an advertising campaign or a marketing campaign. Rather, Linden describes the token as a hard to guess number, *see* col. 4, lines 45-56, which in one embodiment of Linden's invention is generated to be unique, *see* col. 8, lines 25-53. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) (emphasis added). Because Linden fails to teach a "promotional" code, no prima facie case of anticipation has been made.

Therefore, the Applicant respectfully submits that Claim 24, as well as Claims 25 and 47, which depend from Claim 24, are in condition for allowance.

Claim 47 depends from Claim 24 and further recites that the coupon is received in encrypted form. Claim 47 also recites that a request for a coupon is transmitted and that the coupon is stored in encrypted form on a non-volatile computer-readable medium.

The relied upon parts of Linden fail to disclose that a request for a coupon is transmitted. To the contrary, Linden suggests that e-mail messages should be sent to recipients who did not request them. *See, e.g.*, FIG. 9.

The relied upon parts of Linden fail to disclose that the coupon is received in encrypted form. The relied upon parts of Linden also fail to disclose that a coupon is stored in encrypted form on a non-volatile computer-readable medium. The Examiner acknowledged that Linden fails to disclose that the e-mail message is encrypted. *See* Office Action, p. 6, lines 6-8. In fact, Linden teaches away from any kind of encryption which would "need to download special authentication software ... to the user's computer." *Abstract*.

The Applicant traverses the official notice taken by the Examiner in the last action that "it is old and well known within the computer and data encryption arts to encrypt data being sent over unsecured networks." *See* Office Action, p. 6, lines 8-11. While encryption itself may have been well known, the teaching away by Linden demonstrates that, as of this application's filing date, encryption was regarded to have significant drawbacks in certain situations. In particular,

Linden lists the drawback being the "need to download special authentication software ... to the user's computer."

Accordingly, the Applicant respectfully submits that Claim 47 is in condition for allowance.

Claims 26-28 and 30-46 stand rejected as allegedly being unpatentable over Lang. Independent Claim 26 recites, in part, "receiving a coupon request."

Lang describes monitoring users closely in order to send them advertisements. ¶¶ 0011-13. It appears that Lang describes the sending of unsolicited advertisements. The relied upon portion of Lang does not disclose receiving requests for the advertisements, or for that matter, receiving requests for coupons.

Independent Claim 26 recites, in part, "collecting device information from a client system, the device information being insufficient to specifically identify a user of the client system."

Lang describes monitoring the web sites or files visited by a user on the Internet, as well as tracking the "past, present, and future physical locations" of the users. ¶¶ 0011-12. Lang collects many other kinds of personal information about users. In addition to the "actual name of the user" Lang teaches the collection of "other personal information about the user, such as name, gender, age, occupation, marital status, etc." in order "to further target the users." ¶ 0017. Plainly, the collection of this personal information does not meet the recited feature of "the ... information being insufficient to specifically identify a user of the client system."

The Examiner evidently relies upon Lang's usage of the word "may" to mean that Lang purportedly teaches an invention which operates in the absence of personally identifiable information. (Lang writes, "The actual name of the user may be used and added to the user file," and, "Other personal information ... may also be collected and added to the user file." ¶ 0017.)

This argument fails for two reasons. First, Lang teaches that one object of the invention is to allow advertisers to track the web sites and files visited by customers on the Internet, and that a second object of the invention is to allow advertisers to track the "past, present, and future physical locations of their customers," such as by GPS (global positioning system) satellites.

¶¶ 0011-12, 0015. As the collection of this highly personal information is the "object of the invention," there is no suggestion in the relied upon part of Lang that the collection of this information is in any way optional. Thus, the teachings of Lang fail to meet the claim limitation that the information is "insufficient to specifically identify a user of the client system." There are at least two reasons that Lang's GPS information is sufficient to specifically identify users. First, Lang describes the on-going tracking by advertisers of the exact physical location of customers using GPS satellites, "twenty-four hours per day, anywhere in the world." ¶ 0023. It would strain credulity to assert that such tracking is "insufficient to specifically identify a user of the client system." Second, Lang states that telephone numbers (which are indubitably sufficient to specifically identify users) are an acceptable substitute for GPS location. ¶ 0023.

Second, while Lang uses the word "may," the word "may" does not mean "totally optional." The Applicant understands the word "may" to mean that Lang teaches that it is permitted or even encouraged to collect users' names, telephone numbers, genders, ages, occupations, etc. Thus, Lang's use of the word "may" does not mean that the Lang advertising system would necessarily work if Lang's advertising system lacked any information beyond the user's visited web pages and physical location. Thus, because Lang teaches the collection of information (e.g., the user's name) which is sufficient to identify a user, Lang does not meet the recited feature.

Independent Claim 26 recites in part, "transmitting the selected coupon." Lang fails to disclose a "coupon," as the Examiner notes on page 5, lines 5-6. The Examiner's reasoning that "coupons" are implicit in Lang's purported disclosure of "marketing, advertising, and promotions" is faulty. *See* Office Action, p. 5, lines 7-11. Lang fails to anticipate Claim 26 for several reasons.

Each of these terms—marketing, advertising, and promotions—describes a very large field, or genus. Federal Circuit law holds that a disclosure of a large genus does not anticipate a claim for a species. The Federal Circuit held in Corning Glass Works v. Sumitomo Electric U.S.A., 868 F.2d 1251, 1262 (Fed. Cir. 1989), rejected the theory that "a claim to a genus would inherently disclose all species." The court explained, "[The publication] is a reference only for

that which it teaches." In Minnesota Mining & Manufacturing v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1572 (Fed. Cir. 1992), the court held that "although [a patent's] specific claims are subsumed in [a prior art reference's] generalized disclosure ..., this is not literal identity." The reference's ranges were "so broad as to be meaningless" and provided no guidance on how to construct a product with the patent's beneficial properties.

Therefore, even if any of the terms could be properly read to subsume the term "coupon," there is nothing in Lang's usage of the words "marketing," "advertising," and "promotions" which might suggest transmitting coupons. *See* Office Action, p. 5, lines 7-11.

First, Lang does not use the word "promotions" at all. The word "promote" does occur, once, in the background paragraph. ¶ 0003. The word "promote" does not occur at all in the description of the invention. The sentence where it occurs says nothing about transmitting promotions, or for that matter, transmitting anything else. The sentence reads:

> "More particularly, this invention relates to a method of marketing wherein an advertiser desiring to promote its goods or services to a targeted group of consumers who use a computer linked to a wide area network."

Similarly, Lang never refers to "promotions" (a noun) at all. Thus, Lang even if a coupon were a kind of promotion, Lang would not disclose transmitting coupons through the word "promotion."

Second, Lang discloses but a single "method of marketing." *See, e.g.*, ¶ 0021 ("Referring to FIGS. 1-3, there is shown a method of marketing..."). There is no disclosure in Lang that this single disclosed method of marketing includes transmitting coupons. Even if one assumed for the sake of argument that transmitting coupons were a method of marketing, transmitting coupons would be a different method of marketing and thus would not be disclosed by Lang.

Lastly, while Lang does disclose transmitting advertising material, *see* Lang Claim 1, there is no disclosure in Lang of transmitting coupons. Office Action, p. 5, lines 5-6. It is impermissible hindsight reasoning for the Examiner to assert that "advertising ... can include coupons" and then conclude that Lang discloses transmitting coupons. Section 2145(X)(A) of the MPEP bars the Examiner from including "knowledge gleaned only from applicant's disclosure." In addition, the Examiner did not properly take notice of the assertion, as required by Section 2144.03 of the MPEP.

Accordingly, the Applicant respectfully submits that Claim 26, as well as Claims 27-28 and 30-43, which depend from Claim 26, are in condition for allowance. Claims 44-46 include limitations similar to those of Claim 26 and are in condition of allowance for at least the same reason.

Claim 49 depends from Claim 26 and further recites that "the coupon is transmitted in encrypted form."

There is simply no motivation in Lang to apply encryption. Elsewhere, the Examiner took official notice that it is well known to encrypt data "to provide a higher level of security to the data" or "protect data." Office Action, p. 5, lines 8-13. However, this motivation is not found in Lang, as the reference does not say that advertising requires "a higher level of security" or that one must "protect [advertising] data." To the contrary, one application of Lang is beaming ads for used cars to anyone driving within two miles of an used car dealership, on the off chance that one of these recipients will decide to come into the dealership to buy a car. ¶¶ 0029-32. There is no suggestion in Lang that the advertisements should be stored encrypted to prevent recipients from accessing them.

Accordingly, the Applicant respectfully submits that Claim 49 is in condition for allowance. Claim 50 includes limitations similar to those of Claim 49 and is in condition of allowance for at least the same reason.

Section 103(a) Rejections

Claims 1-3, 5-18 and 22, 23 stand rejected as allegedly being unpatentable over Linden in view of Lang. Claim 1 depends from Claim 24. As addressed above, Linden fails to teach a promotional code contained in a URL associated with a coupon. Lang fails to remedy this deficiency. As discussed above, Lang does not contain the word "promotional" at all, and a computerized search reveals that Lang does not contain the word "URL" either.

Additionally, as addressed above, Lang fails to teach "device information being insufficient to specifically identify the user." Linden fails to remedy this deficiency. Indeed,

Linden teaches that a "user's e-mail address and a time stamp" should be encoded into the token, and then the token should be embedded into a URL. Col. 8, lines 13-16.

Therefore, Claim 1 is in condition for allowance. Claims 2-3, 5-18 and 22-23 include limitations similar to those in Claim 1 and are in condition for allowance for at least the same reason.

Claim 4 stands rejected as allegedly being unpatentable over Linden in view of Lang and Barnett. Claim 4 depends from Claim 1. As addressed above, Linden and Lang, alone and in combination, fail to teach or suggest "device information being insufficient to specifically identify the user, as required by Claim 1. Barnett fails to remedy the deficiency, as it teaches that users' social security numbers (which specifically identify the users) should be bar-coded onto every coupon the users print. These social security numbers are intended to be scanned and then used for demographic analysis. See col. 11, lines 2-10. Accordingly, Claim 4, as well as Claim 48 which depends from Claim 4, is in condition for allowance.

Claim 29 stands rejected as allegedly being unpatentable over Lang in view of Barnett. Claim 29 depends from Claim 26. As addressed above, Linden, Lang, and Barnett, alone and in combination, fail to teach or suggest "device information being insufficient to specifically identify the user, as required by Claim 26. Accordingly, Claim 29 is condition for allowance.

Conclusion

The Applicant respectfully requests that all pending claims be allowed.

By responding in the foregoing remarks only to particular positions taken by the examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Please apply the excess claim fees and any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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